



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/798,551

03/12/2004

James J. Darr

20874.101C1US

6462

41434

7590

02/02/2009

PATTON BOGGS LLP

2550 M STREET NW

WASHINGTON, DC 20037-1350

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

02/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/798,551	Applicant(s) DARR, JAMES J.	
	Examiner OJO O. OYEBISI	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 and 12-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the notice of non-compliant amendment mailed 10/17/08, the applicant disagrees with the notice of non-compliant amendment, arguing that claim 17 was indeed amended. Applicant's argument is convincing and the notice of non-compliant amendment is hereby withdrawn. However, applicant's amendment, dated 06/26/08, has given the claimed subject matter divergent scope and utility. And this has necessitated the restriction requirement set forth in this office action.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 12-17, and 20-24 drawn to a method for raising funds for a first organization comprising: identifying one or more individuals associated with the first organization; requesting enrollment of the one or more identified individuals in a program permitting the first organization to take out an insurance policy on each life of the one or more identified individuals naming the first organization as beneficiary, and granting the first organization an irrevocable right to utilize the insurance policy on each life of the one or more identified individuals to serve the best interests of the first organization; receiving information from one or more of the identified individuals accepting the enrollment; selecting one or

Art Unit: 3696

more of the one or more enrolled individuals based upon the received information to create a financial instrument comprising one or more insurance policies for each of the selected individuals, wherein the one or more insurance policies are selectively grouped based upon actuarial matrices or formulas into the financial instrument; facilitating payment of premiums for the financial instrument; holding the a financial instrument of the a first organization in a passive vehicle; providing, by a second organization, capital to the first organization as evidenced by a promissory note secured by the financial instrument; transferring, a right or a benefit that the passive vehicle receives with respect to the financial instrument as repayment of the promissory note to the second organization, classified in class 705, subclass 35.

- II. Claims 18-19, drawn to a method for raising funds for a first organization comprising: identifying insurable interests associated with the first organization; requesting authorization for the first organization to insure the insurable interests; taking out one or more policies insuring the insurable interests, wherein the insurable interests are the lives of a plurality of individuals associated with a first non profit organization; naming the first organization as the beneficiary of the one or more policies; selectively grouping the one or more policies based upon actuarial matrices or formulas; transferring receiving funds as evidenced by a promissory note secured by each grouping of the one or more

policies to the first organization; repaying the promissory note by transferring one or more benefits and/or rights from the one or more policies, classified in class 705, subclass 4.

2. The inventions are distinct, each from the other because of the following reasons:

- Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method for raising funds for a first organization comprising: identifying **one or more individuals** associated with the first organization, **requesting enrollment of the one or more identified individuals in a program** permitting the first organization to take out an insurance policy on each life of the one or more identified individuals naming the first organization as beneficiary, and granting the first organization an irrevocable right to utilize the insurance policy on each life of the one or more identified individuals to serve the best interests of the first organization; **receiving information from one or more of the identified individuals accepting the enrollment**; selecting one or more of the one or more enrolled individuals based upon the received information to create a financial instrument comprising one or more insurance policies for each of the selected individuals, whereas invention II has a different utility and scope of identifying **insurable interests** associated with the first organization; **requesting authorization for the first organization to insure the insurable**

Art Unit: 3696

interests; taking out one or more policies insuring the insurable interests, wherein the insurable interests are the lives of a plurality of individuals associated with a first non profit organization; **repaying the promissory note by transferring one or more benefits and/or rights from the one or more policies**. The examiner contends that the insurable interests mentioned in Group II is too broad, it encompasses so many things i.e., individual's life, things, animals etc. Further, group I mentions **requesting enrollment, and group II mentions requesting authorization**. Hence inventions I and II have recognized divergent subject matter, and the search required for Group I is not required for Group II.

3. Since these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicants are advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is


Art Unit: 3696

571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Examiner, Art Unit 3696

10798551

<div><i>Application Number</i></div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/798,551	DARR, JAMES J.	
	Examiner	Art Unit	
	OJO O. OYEBISI	3696	